

1 in the original specification (English translation) at page 2, lines 14 to 17. In particular, the text
2 of the original specification at page 2, lines 14-17 indicates that the product stack is first fastened
3 with the fastening cover and “then” the stack is clamped with the clamping jaws. The
4 independent operation of the clamping jaws is also apparent from Figure 1 which show the
5 fastening cover D pivoted down and the clamping jaws K pivoted away from the product stack.

6 Claims 36 and 41 are amended to require that the rear wall is separable into two wall
7 elements that are movable in the plane defined by the rear wall. The limitation is set out in the
8 original disclosure at page 4, lines 24-26 for example.

9 Because the new claims are fully supported by the original specification, the new claims
10 do not introduce new matter.

11
12 II. THE CLAIMS ARE NOT OBJECTIONABLE UNDER 35 U.S.C. §112, FIRST
13 PARAGRAPH

14 The Office Action rejected claim 23 under 35 U.S.C. §112, first paragraph, on the ground
15 that the disclosure was not enabling for the claim limitation that the foot element was movable in
16 the Z direction. The Applicants traverse this rejection.

17 It is noted that the limitation which prompted the Section 112 first paragraph rejection has
18 been removed from the independent apparatus claim in connection with removing the phrase
19 “and/or.” However, the limitation that the foot element is movable in the Z direction is
20 incorporated in new dependent claim 51.

21 The issue with regard to enablement of claimed subject matter revolves around whether
22 the disclosure, when filed, contained sufficient information to enable one skilled in the pertinent
23 art to make and use the claimed invention. The application in this case provides no detail

1 regarding how the foot element may be supported to facilitate the claimed linear motion. The
2 application does, however, disclose that the various components of the apparatus may be driven
3 with suitable drives including hydraulic drives, linear drives, and pneumatic drives. Regardless
4 of the lack of details regarding the linear movement of the foot element, the Applicants submit
5 that one of ordinary skill in the art would immediately recognize any number of arrangements
6 that would support the claimed linear movement of the foot element. Merely stating that the foot
7 element is supported for such linear movement enables one of ordinary skill in the art to practice
8 the invention. Therefore, the Applicants submit that the limitation now set out in claim 51 is
9 fully enabled by the present disclosure and is not objectionable under Section 112, first
10 paragraph.

11 The Applicants note the comment in the Office Action in the middle of page 2 regarding
12 the number of possible alternatives to produce the claimed linear movement of the foot element.
13 However, the Applicants respectfully submit that the number of implementations available to
14 effect the claim limitation is not relevant under Section 112, first paragraph. As long as one of
15 ordinary skill in the art could make and use the claimed invention, the enablement requirement is
16 met. In this case claim 51 requires that the movement of the foot element is in direction Z.
17 Anyone with basic mechanical skill can envision any number of ways to effect this desired linear
18 movement of the foot element. Thus, the limitation regarding linear movement of the foot
19 element is enabled.

1 III. THE CLAIMS ARE NOT ANTICIPATED BY THE CITED ART

2 The Office Action rejected claims 17-24, 26-29, and 31-32 under 35 U.S.C. 102(b) as
3 being anticipated by U.S. Patent No. 4,498,381 to Convey, Jr. ("Convey" or the "Convey
4 patent"). The Applicants respectfully submit that the new claims are not anticipated by Convey.

5 The Convey patent is directed to a stacking device for stacking pages of printed material
6 referred to as "signatures." Convey discloses a transfer vehicle 28 that picks up a stack of
7 signatures and delivers it to a tying station 16. It is apparent from Figures 2 and 7 of Convey that
8 the stack is supported on its lateral sides by portions 46c and 46d of the upper clamp 46 and
9 perhaps portions 48a and 48b of lower clamp 48. That is, the lateral support is provided by the
10 same components that clamp the stack from above and below. It is not possible in the Convey
11 device for the lateral support to be applied to the stack independently of the upper and lower
12 clamping.

13 Claims 33-38

14 Element (b) of Applicants' claim 33 requires:

15 independently of fastening the product stack between the first transport element and the
16 fastening cover, clamping the product stack between at least two additional opposite side
17 surfaces thereof with at least two clamping jaws, the at least two additional opposite side
18 surfaces being located between the upper and lower ends of the product stack.

19 Comparing this requirement to Convey, it is apparent that Convey does not include clamping the
20 stack between two additional opposite sides **independently** of fastening the stack from above
21 and below. Thus, the Convey patent does not disclose element (b) of claim 33.

22 Referring to the Convey patent at col. 7, lines 11-30, once a stack of signatures is picked
23 up by the transfer vehicle 28, it is delivered to the tier station 16 where the stack is tied while still
24 clamped on the clamping mechanism 30 of the transfer vehicle. The clamping mechanism 30 of

1 the transfer vehicle only releases the stack once it is tied. Thus Convey also does not disclose the
2 foot element displacing step required at element (c) of claim 33, and none of steps (d), (e), and
3 (f).

4 Because the Convey patent does not disclose each element required in claim 33, the
5 Applicants respectfully submit that claim 33 and its dependent claims, claims 34-38, are not
6 anticipated by the Convey patent.

7 Claims 39-52

8 New independent claim 39 is directed to an apparatus and includes the following
9 limitations at element (d):

10 a first clamping jaw located at a right side of the rear wall and a second clamping jaw
11 located at a left side of the rear wall, the first clamping jaw and second clamping jaw each
12 being moveable independently of the foot element and fastening cover to clamp the
13 product stack between a right side of the product stack and a left side of the product stack.

14 As set out above with reference to claim 33, the Convey patent does not disclose any side
15 clamping jaws that operate independently of the top and bottom clamping elements. Rather, the
16 lateral clamps disclosed in Convey are simply part of the top and bottom clamps and cannot
17 move independently. Thus Convey does not disclose the independently operating clamping jaws
18 required at element (d) of claim 39.

19 Because the Convey patent does not disclose each element required in claim 39, the
20 Applicants respectfully submit that claim 39 and its dependent claims, claims 40-52, are not
21 anticipated by the Convey patent.

22 It is noted that in making the anticipation rejections in view of Convey, the Office Action
23 defines the elements 54 in Convey as side clamping jaws. However, elements 54, specifically
24 54c, contact only the front surface of the stack and do not clamp the stack at opposing sides.

1 Thus elements 54 do not satisfy the requirements of the clamping jaws set out in claim 39 and do
2 not perform the clamping steps required in claim 33.

3
4 IV. THE CLAIMS ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES

5 The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over
6 Convey in view of U.S. Patent No. 3,123,323 to Postlewaite (the "Postlewaite patent" or
7 "Postlewaite") and rejected claim 30 over Convey in view of U.S. Patent No. 3,724,089 to
8 Thompson et al. ("Thompson" or the "Thompson patent"). The Applicants respectfully submit
9 that the amended claims are not obvious over the cited references because the proposed
10 combinations of references do not include each element required in the new claims.

11 The Office Action cites Postlewaite as to claim 25 for showing two rear wall elements 33
12 and 47. However, the two elements 33 and 47 in Postlewaite lie in different planes. New claims
13 36 and 41 more clearly recite the intended limitation regarding the dividable rear wall.
14 Specifically, these claims require that the two wall elements are separable in the plane defined by
15 the rear wall. Postlewaite does not teach or suggest this dividable rear wall feature now set out in
16 claims 36 and 41. It is also noted that Postlewaite does not make up for the deficiencies of the
17 Convey patent as to the independent claims.

18 Because the proposed combination of Convey and Postlewaite does not teach or suggest
19 each element required the new claims, including claims 36 and 41 directed to the dividable rear
20 wall, the Applicants submit that the claims are not obvious in view of Convey and Postlewaite
21 and are entitled to allowance.

1 As to claim 30 the Office Action cites Thompson for showing a vibration element to aid
2 in the alignment of stacked items. The vibration element previously referenced in claim 30 is
3 now included in claim 46.

4 The Thompson patent does not make up for the deficiencies of the Convey patent as to
5 the independent claims. Therefore the proposed combination of Convey and Thompson fails to
6 disclose each element required in the new claims.

7 Because the proposed combination of Convey and Thompson does not teach or suggest
8 each element required in the new claims, the Applicants submit that the claims are not obvious in
9 view of Convey and Thompson and are entitled to allowance.

10
11 V. CONCLUSION

12 For all of the above reasons the Applicants respectfully request consideration and
13 allowance of new claims 33-52.

14 If the Examiner should feel that any issue remains as to the allowability of these claims,
15 or that a conference might expedite allowance of the claims, he is asked to telephone the
16 undersigned attorney at the number listed below.

17 Respectfully submitted,

18 The Culbertson Group, P.C.

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22 Dated: 27 June 2005

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